

REMARKS

STATUS OF CLAIMS:

Claims 8-32 are pending in the application. Claims 9, 10, 12-26, 28, 29, 31 and 32 are withdrawn from consideration. Claims 8, 11, 27 and 30 have been examined.

DOUBLE PATENTING:

The Examiner rejected claims 8, 11, 27 and 30 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 2 of U.S. Patent No. 6,289,650. In response to the double patenting rejection, Applicants submit herewith a duly executed Terminal Disclaimer.

Accordingly, Applicants respectfully request that the double patenting rejection of claims 8, 11, 27 and 30 be withdrawn.

35 U.S.C. §102:

Claims 8, 27 and 30 are rejected under 35 U.S.C. §102(b) as being anticipated by Dirx (U.S. Patent No. 5,649,411). This rejection is respectfully traversed in view of the following remarks.

Applicants submit that rejections under 35 U.S.C. §102 are proper only when each element of the claimed subject matter is disclosed in the cited reference. Dirx fails to teach or suggest each element of the claimed subject matter. Claims 8 and 30 are directed to a novel combination of elements that form a new and unobvious printing plate packaging box.

For example, and not by limitation, claims 8 and 30 recite, *inter alia*, "...the light-shielding member being connected to the opening/closing lid..." This recitation can correspond to the side plate portions 48B and 48C of the opening/closing lid 48 shown in Fig. 4 of the present application. The light-shielding member of the claims is also described as being connected to the opening/closing lid such that the light-shielding member blocks the direct entry

of light from outside into the inside of the box through the zone in which the box main body and the opening/closing lid are contacted to each other in the assembled state.

The Examiner initially took the position that the lighttight wrapping foils (40, 41) of Dirx are equivalent to the aforementioned light-shielding member of claim 8. However, as shown in Fig. 5C of Dirx, the lighttight wrapping foils (40, 41) are nothing more than wrapping sheets for wrapping the stack (10) to form a packet (9). The resulting packet (9) is accommodated in a package formed by the base (44) and cover (46).

In contradistinction, the presently amended claims 8 and 30, for example, distinguish over Dirx in that “the light-shielding member” of the present invention is “connected to the opening/closing lid,” while the lighttight wrapping foils (40, 41) of Dirx are connected to neither the cover (46) nor the base (44).

Furthermore, one skilled in the art would not have been motivated to connect the light-tight wrapping foils (40, 41) of Dirx to the cover (46). Thus, due to the application of Dirx failing to disclose each element of the claimed subject matter, Applicants respectfully-submit that the rejection of claims 8 and 30 under 35 U.S.C. §102(b) should be withdrawn. Dirx also does not anticipate claim 27, at least because it depends from claim 8, in addition to its individual recitations.

35 U.S.C. §103:

Claim 11 is rejected under 35 U.S.C. §103(a) as being obvious over Dirx. Applicants respectfully traverse this rejection in view of the following remarks

To establish a *prima facie* case of obviousness, the Examiner must show, among other things, that there is some suggestion or motivation in the reference, or in the knowledge generally available to one of ordinary skill in the art, to modify the reference as asserted. There is no motivation to add the sheet-type material, which is described as being smooth and airtight, to the outer surface of the cover 46 in Dirx. Although the Examiner asserts that one would make such

a combination so as to make the packaging box "air tight," there is no motivation in Dirx to do so.

The Examiner has not supplied a reference that teaches the claimed sheet-type material, but instead takes Official Notice and alleges that such a feature is old and conventional. Applicants respectfully submit that the Examiner may not rely on Official Notice or judicial notice, or a mere statement of obviousness at a point where patentable novelty is argued, but must come forward with pertinent prior art (see *Ex parte Cady*, 148 USPQ 162 (Bd. of App. 1965)). Here, one of the points of novelty of this embodiment is the inclusion of the sheet-type material having the features recited in the claims, which is adhered to an outer surface of the opening-closing lid. The Examiner has not cited any prior art that teaches or suggests this novel aspect of the present invention.

Applicants respectfully submit that claim 11 is patentable over Dirx due to its individual recitations, and because it depends on claim 8, which Dirx does not render obvious. Thus, the rejection of claim 11 under 35 U.S.C. §103(a) should be withdrawn.

In view of the preceding amendments and remarks, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If there are any points remaining in issue that the Examiner feels may be best resolved through a personal or telephonic interview, the Examiner is kindly requested to contact the undersigned attorney at the local telephone number listed below.

AMENDMENT UNDER 37 C.F.R. §1.111
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Q65607

The USPTO is directed and authorized to charge all required fees (except the Issue Fee and/or the Publication Fee) to our Deposit Account No. 19-4880. Please also credit any overpayment to said Deposit Account.

Respectfully submitted,

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PATENT TRADEMARK OFFICE

Date: February 14, 2003

APPENDIX

VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE CLAIMS:

The claims are amended as follows:

8. (Thrice amended) A printing plate packaging box comprising:
- a box main body which accommodates a bundle of photosensitive printing plates and which is provided with a supply opening through which the photosensitive printing plates are taken out;
 - an opening/closing lid which is removably attached to said box for opening/closing the supply opening; and
 - a light-shielding member which prevents direct entry of light from outside into the inside of the box main body, provided in the vicinity of a zone in which the box main body and the opening/closing lid are contacted to each other in an assembled state, the light-shielding member being connected to the opening/closing lid such that the light-shielding member blocks the direct entry of light from outside into the inside of the box through the zone in which the box main body and the opening/closing lid are contacted to each other in the assembled state.
30. (Amended) A combination of a printing plate packaging box and a bundle of photosensitive printing plates, comprising:
- said bundle of photosensitive printing plates; and
 - said printing plate packaging box including,
 - a box main body which accommodates said bundle of photosensitive printing plates and which is provided with a supply opening through which said photosensitive printing plates are taken out; [and]

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an opening/closing lid which is removably attached to said box for opening/closing the supply opening; and

a light-shielding member being connected to the opening/closing lid such that the light-shielding member blocks the direct entry of light from outside into the inside of the box through a zone in which the box main body and the opening/closing lid are contacted to each other in the assembled state.